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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
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| 09/658,387  | 09/08/2000  | Aureliano Tan JR.    | 05452.002002                    | 3461                        |
| 22511 7590 01/02/2008<br>OSHA LIANG L.L.P.<br>1221 MCKINNEY STREET<br>SUITE 2800<br>HOUSTON, TX 77010 |             |                      | EXAMINER<br>KLIMACH, PAULA W    |                             |
|   |             |                      | ART UNIT<br>2135                | PAPER NUMBER                |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
buta@oshaliang.com

# Office Action Summary

Application No.

09/658,387

Applicant(s)

TAN, AURELIANO

Examiner

Paula W. Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 8, 9, 34, 64, 69 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-9, 69, 34, 64, 72-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A pre-appeal conference was formed and conferee agreed that there is no reason to combine Jones and Cooper, the finality of the office action is now withdrawn.

In view of the pre-appeal brief filed on 09/25/07, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Response to Arguments***

Applicant's arguments filed 09/25/07 have been fully considered but they are not persuasive because of following reasons.

Applicant argued Cooper discloses a machine id and does not correspond to the microprocessor id. This is not found persuasive. The machine id identifies the components within the machine and therefore is microprocessor. Furthermore with the newly cited reference, Ward, the id is etched onto the microprocessor and therefore is an integral part of the microprocessor.

The applicant argues further that Friedman does not teach the storing a name of a corporate officer. This is found persuasive, Cooper teaches the customer key which corresponds

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to the name of the cooperate officer. The customer key performs the function of identification as a name would perform.

The applicant argues that the references do not teach a digital identity device including two separate memories, one for the digital identity and another for the operating system. This is not persuasive because the Cooper reference teaches the computer hard drive for the operating system and the floppy disk for the removable key as in figure 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 8-9, and 69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (5,689,560) and in view of Ward et al (6,083,771).

*In reference to claim 1*, Cooper discloses a method and apparatus is provided for distributing software objects from a producer to a potential user (abstract). The system of Cooper includes a microprocessor (machine identification, column 14 lines 21-33), digital identity data, wherein the digital identity data uniquely identifies a user of the digital identity device (column 14 lines 21-22). Microprocessor identity that is encrypted (column 14 lines 51-53) by the digital identity data using an algorithm that uses a random number (column 14 lines 55-65). The system discloses the encryption of personal information (key file) using serial number (key; column 15 line 62 to column 16 line 9). Cooper further discloses a digital identity

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that comprises a name of the owner (column 13 lines 10-17), wherein the microprocessor identity is an alpha-numeric value (column 13 line 65 to column 14 line 5).

Although Cooper disclose the encryption of user data with a key derived from a machine id and microprocessor and the encryption of the user data, Cooper does not disclose etching the id on the microprocessor.

Ward discloses a method and system for manufacturing theft-deterrent computer components is disclosed. In the system of Ward the identifier (serial number) is etched to the computer component (column 3 lines 3-13) such as a microcontroller (column 1 lines 15-20).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the identifier into the controller as performed by Ward in Cooper. One of ordinary skill in the art would have been motivated to do this because the computer is typically comprised of many component with some of which are more expensive than others and etching the serial number to the microprocessor combats the microprocessor being taken from the computer (Ward column 1 lines 25-32).

*In reference to claim 8*, wherein the digital identity device further comprises a computer an interface configured to enable the digital identity device to communicate with an external device (Fig. 1).

*In reference to claim 9*, wherein the interface comprises an input/output port (Fig. 1).

*In reference to claim 69* wherein the owner is a corporation, wherein the name is an incorporation name of the corporation, and wherein the digital identity data comprises at least one selected from the group consisting of a data and place of incorporation of the corporation, a name of a corporate officer of the corporation, and corporate partner of the corporation. Cooper

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teaches the customer key (Fig. 18). The customer key corresponds to a name because of the identifying function or qualities of the customer key, which is the function of a name.

**Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Ward as applied to claims 1 and 34 above, and further in view of the article by Friedman ("The Trustworthy Digital Camera: Restoring Credibility To The Photographic Image").

*In reference to claim 6*, wherein the digital identity is for one of the group consisting of an individual and a corporation; and wherein the digital identity at least one selected from the group consisting of a digital picture, an address, a date of birth, a social security number, a driver's license number, a digital photograph, biometric information, credit card information, and a database administrator name.

Friedman discloses a digital identity in form of a digital photograph (image; page 908 column 2, the first full paragraph).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the key into the controller as performed by Friedman in the system of Cooper. One of ordinary skill in the art would have been motivated to do this because credibility of the camera's output becomes an extension of that of the manufacturer; thus a digital signature from the camera can be considered to be just as reliable and secure as if the signature had been generated by the manufacturer (Friedman page 908 column 1, the first full paragraph).

**Claims 34, 64, and 72-74** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Ward as in claim 1 and further in view of Guthery and Yap et al (6,111,506) and further in view of Paolini (6,847,948).

*In reference to claims 34 and 73*, is rejected as disclosed in claim 1 above. In reference to claim 73, Cooper teaches and two separate memories; (i) a digital identity device including two separate memories; (ii) digital identity data stored in the first memory; and (iii) an operating system in the second memory binding the digital identity data and the microprocessor identity (Fig. 1). The additional limitation of obtaining digital identity data from a digital device operatively connected to a computer in which the electronic document is stored is taught by Guthery.

Guthery discloses a computer having a microprocessor containing identity information (column 5 lines 25-40 in combination with column 6 line 49 to column 7 line 5). The system includes obtaining digital identity data from a digital identity device operatively connected to a computer in which the electronic document is stored (Fig. 1). Guthery discloses a system that comprises a microprocessor (Fig. 2 part 52). Guthery further discloses a system that comprises digital identity data wherein the digital identity data is associated with a user of the digital identity device; a memory configured to store at least the digital identity data (column 5 lines 7-15; column 6 lines 44-50; column 7 lines 13-21; Fig 2 part 58).

Guthery discloses a card ID (column 7 lines 1-5) which possesses as the microprocessor identity due to the fact that the card ID belongs to the card; and therefore everything on the card and the card only has one microprocessor (Fig. 2). It follows that the ID identifies the contents of the card and therefore identifies the microprocessor. Even if the card ID is not a

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microprocessor identity, Paolini discloses a method and apparatus is disclosed for preventing an unauthorized computer system from using copied software of data (abstract). The system uses a CPU ID (microprocessor ID) of a particular computer system (column 3 lines 1-5).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a microprocessor ID in the smart card of Paolini in the system of Guthery. One of ordinary skill in the art would have been motivated to do this because the ID is a unique quantity that can be used to prevent the use of copied software.

Although Guthery discloses storing information such as licenses and therefore documents (column 6 lines 45-50) and the system has passwords (column 6 lines 62-67) and a program for encryption (column 6 lines 25-30), Guthery does not disclose encrypting the documents

Yap discloses storing documents on the smart card. The documents are encrypted.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to encrypt the documents as in Yap with the digital identity data of Guthery and storing the documents on the smart card as in Guthery. One of ordinary skill in the art would have been motivated to do this because it would discourage fougery.

Guthery and Paolini do not disclose the etching of the microprocessor identity information into the microprocessor

Ward discloses a method and system for manufacturing theft-deterrent computer components is disclosed. In the system of Ward the identifier (serial number) is etched to the computer component (column 3 lines 3-13) such as a microcontroller (column 1 lines 15-20).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the identifier into the controller as performed by Ward in Cooper. One of

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ordinary skill in the art would have been motivated to do this because the computer is typically comprised of many component with some of which are more expensive than others and etching the serial number to the microprocessor combats the microprocessor being taken from the computer (Ward column 1 lines 25-32).

*In reference to claim 72* wherein the owner is a corporation, wherein the name is an incorporation name of the corporation, and wherein the digital identity data comprises at least one selected from the group consisting of a data and place of incorporation of the corporation, a name of a corporate officer of the corporation, and corporate partner of the corporation. Cooper teaches the customer key (Fig. 18). The customer key corresponds to a name because of the identifying function or qualities of the customer key, which is the function of a name.

*In reference to claims 64 and 74*, wherein the digital identity is for one of the group consisting of an individual and a corporation; and wherein the digital identity at least one selected from the group consisting of a digital picture, an address, a date of birth, a social security number, a driver's license number, a digital photograph, biometric information, credit card information, and a database administrator name (bank information, column 7 lines 45-47; and column 6 lines 47).

**Claim 75** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Ward and further in view of Guthery and further in view of Yap and further in view of Paolini as applied to claim 73 above, and further in view of the article by Friedman.

*In reference to claim 75* wherein the owner is a corporation, wherein the name is an incorporation name of the corporation, and wherein the digital identity data further comprises at

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least one selected from the group consisting of an incorporation name of the corporation, a data and place of incorporation of the corporation, a name of a corporate officer of the corporation, and corporate partner of the corporation.

Friedman discloses a method securing a digital image (abstract). The image is secured using a unique key, therefore identification, which is etched to the camera's secure microcontroller (page 908 column 2, the first full paragraph).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to etch the key into the controller as performed by Friedman in the system of Cooper. One of ordinary skill in the art would have been motivated to do this because credibility of the camera's output becomes an extension of that of the manufacturer; thus a digital signature from the camera can be considered to be just as reliable and secure as if the signature had been generated by the manufacturer (Friedman page 908 column 1, the first full paragraph).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-38544. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK

Tuesday, December 18, 2007

A handwritten signature in black ink, appearing to read 'Thanhnga B. Truong', with a stylized flourish at the end.

THANHNGA TRUONG  
PRIMARY EXAMINER